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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/767,519 | 01/29/2004 | Marc C. Piscitello | 14935US01 | 5528 |
| 23446 | 7590 | 01/30/2006 | EXAMINER | |
| MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661 | | | CHOI, STEPHEN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/767,519 | Applicant(s) PISCITELLO, MARC C. | |
| | Examiner Stephen Choi | Art Unit 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of group I in the reply filed on 30 December 2005 is acknowledged. The traversal is on the ground(s) that groups II-IV could be searched and examined together with the elected group since they are sufficiently related in technical subject matter to the elected group. This is not found persuasive because the claimed inventions are distinct for the following reason. The invention claimed in the linking claim 1 is determined to be not patentable as shown below, leaving claims joined thereby without a common inventive feature. Thus, inventions of groups I-III **as claimed** are distinct and separate inventions. For example, the invention of group I **as claimed** does not require the plurality of slots of group II **as claimed** for patentability as evidenced by the omission thereof from group I, and conversely, the invention of group II **as claimed** does not require the knife holder formed of elastomeric material of group I **as claimed** for patentability as evidenced by the omission thereof from group II. Furthermore, the invention of group IV can be practiced by another materially different apparatus as set forth in the previous office action.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: '19' and '20'. The drawings are also objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in

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the claims. Therefore, the fastener and receptacles set forth in claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-6, 10-11, 14-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by McMahon et al. (US 4,640,165).

McMahon discloses all the recited elements of the invention including:

- a) a knife roller (e.g., 10);
- b) a cooperating anvil roller having an anvil (e.g., 20);
- c) at least one knife carrying unit comprising a knife holder formed of a resilient elastomeric material (e.g., 30), at least one shaped slot having a circumferentially extending component (e.g., 32a or 32b has a width extending circumferentially) and at least one shaped cutting knife having at least one radially outwardly presented cutting edge (e.g., 34a or 34b).

Regarding claims 2, 5-6, and 17, col. 2, lines 51-53. Regarding claims 10-11, col. 4, lines 66-67. Regarding claims 14-15, col. 1, lines 5-7. Regarding claim 17, a retention mechanism (e.g., 36, 38, 44, 48).

5. Claims 1 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bugnone (US 4,248,117).

Bugnone discloses all the recited elements of the invention including:

- d) a knife roller (e.g., 18);
- e) a cooperating anvil roller having an anvil (e.g., 16);
- f) at least one knife carrying unit comprising a knife holder (e.g., 24), at least one shaped slot having a circumferentially extending component (e.g., 30) and at least one shaped cutting knife having at least one radially outwardly presented cutting edge (e.g., 20).

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Regarding claim 11, col. 1, line 51. Regarding claims 12-13, see Figure 4. Regarding claims 14-15, the web material is not part of the invention. It merely recites the manner in which a claimed apparatus is intended to be employed. Bugnone satisfies all the claimed structural limitations thus, capable of cutting the recited web material.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Von Schrittz, Kapolnek '093, '065, and Lopez Ascaso et al. are cited to show related devices.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SC
26 January 2006

STEPHEN CHOI
PRIMARY EXAMINER